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10/796,506	03/09/2004	Jeffery M. Enright	D-1243	1933
28995	7590	10/30/2008	EXAMINER	
RALPH E. JOCKE			RAO, ANAND SHASHIKANT	
walker & jockey LPA				
231 SOUTH BROADWAY			ART UNIT	PAPER NUMBER
MEDINA, OH 44256			2621	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/796,506	<b>Applicant(s)</b> ENRIGHT ET AL.
	<b>Examiner</b> Andy S. Rao	<b>Art Unit</b> 2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 7/3/08.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-26, 28 and 29 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-26, 28-29 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/0256/06)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's arguments directed towards to applied Mair reference (Amendment of 7/3/08: page 9, lines 7-22; page 10, lines 1-25; page 11, lines 1-10) are moot in view the new grounds of rejection.
2. Applicant's argument that the invention of the instant application is entitled to the priority dates of the parent **continuation-in-part** applications of 10/601,950 and #09/414,249 is not persuasive (Amendment of 7/3/08: page 11, lines 11-24; page 12, lines 1-10). It is duly noted that the scope of the claims 1-26 and 28-29 of the current instant invention are directed towards material that is supported by the '950 application, but not the '249 application and thus **does not get the benefit of the filing date of the '249 application as an effective date for excluding relevant art**. In particular, the '249 application is directed towards transaction data imaging at an ATM and not imaging of a specific element at an ATM input interface such as a fascia or card reader for fraud detection/prevention as in the current application. Accordingly, the effective filing date of the instant invention of the application is 11/26/02 (i.e. the filing date of the provisional application #60/429,478 associated with the '950 application). Therefore, Mair remains applicable prior art since its filing date is 4/3/00 and thus precedes the effective filing date of the instant application. A rejection based on newly discovered art follows.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(c) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-26, 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Clark.

Clark discloses a method (Clark: column 3, lines 24-32) comprising: capturing with an imaging device (Clark: column 4, lines 1-5), first image data corresponding to an image of at least a portion of a user interface of an automated banking machine that includes a cash dispenser (Clark: column 4, lines 5-10), and storing the first image data in at least one data store through operation of at least one processor (Clark: column 4, lines 20-23); subsequent to, capturing with the image device, second image data corresponding to an image of at least a portion of the user interface of the automated banking machine (Clark: column 4, lines 35-37); comparing the first image data and the second image data through operation of at least one processor to determine if there is at least a level of change between the first and second image data (Clark; column 4, lines

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38-42); responsive to determining at least the level of change, taking at least one programmed action responsive to operation of the at least one processor (Clark; column 4, lines 43-48), as in claim 1.

Regarding claim 2, Clark discloses wherein the portion of the user interface includes a card accepting opening (Clark: column 3, lines 55-50), as in the claim.

Regarding claims 3-4, Clark discloses wherein the at least one response includes sending at least one message to at least one remote system address (Clark: column 3, lines 10-15), as in the claims.

Regarding claims 5-7, Clark discloses executing at least one test to determine if an unauthorized card reading device has been installed (Clark: column 2, lines 55-60), as in the claims.

Regarding claim 8, Clark discloses rendering the machine inoperative (Clark: column 5, lines 15-20), as in the claim.

Regarding claims 9-12, Clark discloses detecting at least one triggering event responsive to operation of the at least one processor, wherein the comparing is performed responsive to the triggering event (Clark: column 4, lines 35-45), as in the claims.

Regarding claim 13, Clark discloses wherein in the triggering event includes sensing opening of a shutter previously blocking a card accepting slot (Clark: column 2, lines 55-60), as in the claim.

Regarding claims 14-16, Clark discloses wherein the at least one triggering event includes an input to at least one key on the user interface of the machine at a time not appropriate in operation of the machine (Clark: column 3, lines 55-59), as in the claim.

Regarding claim 17, Clark discloses that the at least one triggering event includes the machine presenting cash to a user that is not taken by the user (Clark: column 3, lines 1-5), as in the claim.

Regarding claim 18, Clark discloses that the triggering event includes at least one user not taking a transaction receipt provided by the machine (Clark: column 3, lines 60-67), as in the claim.

Regarding claim 19, Clark discloses that the triggering event includes the machine being able to satisfactorily complete a plurality of transactions (Clark: column 3, lines 50-55), as in the claim.

Regarding claims 20-26, Clark discloses causing the at least one processor to execute at least one action in a programmed sequence corresponding to the triggering event (Clark: column 4, lines 20-25), as in the claims.

Clark discloses at least one computer readable medium including computer executable instructions (Clark: column 4, lines 53-57, wherein the instructions, when executed by at least one computer (Clark: column 4, lines 10-15), cause: capture responsive to operation of an imaging device of first image data corresponding to an image of at least a portion of a user interface (Clark: column 3, lines 45-50) of an automated banking machine that includes a cash dispenser (Clark: column 4, lines 1-10); computer produced storage of the first image data in at least one data store (Clark: column 4, lines 13-16); capture responsive to operation of the imaging device of second image data corresponding to an image of at least a portion of the user interface of the automated banking machine (Clark: column 4, lines 35-40), subsequent to capture of first image data (Clark: column 4, lines 17-20); computer comparison of the first

image data and the second image data to determine if there is at least a level of change between the first image data and second image data (Clark: column 4, lines 40-47); and at least one computer programmed action responsive to a determination of at least the level of change (Clark: column 4, lines 55-62), as in claim 28.

Clark discloses a method (Clark: column 3, lines 23-32), comprising: (a) capturing responsive to operation of an imaging device (Clark: column 4, lines 1-5), a first image of at least a portion of a user interface (Clark: column 4, lines 13-16) of an automated banking machine that includes a cash dispenser (Clark: column 3, lines 46-53); (b) subsequent to step (a), capturing responsive to operation of the image device (Clark: column 4, lines 10-15), a second image of the at least a portion of the user interface of the automated banking machine (Clark: column 4, lines 17-20); (c) determining through operation of at least one processor if there is at least a predetermined level of change between the first image captured in step (a) and the second image captured in step (b) (Clark: column 4, lines 35-42); and (d) responsive to a determination in step (c) of at least the predetermined level of change between the first image and second image (Clark: column 4, lines 43-48), taking at least one programmed action responsive to operation of the at least one processor (Clark: column 4, lines 45-49), wherein the at least one programmed action includes: (di) executing at least one test to determine if an unauthorized device has been installed to the automated banking machine (Clark: column 4, lines 50-55); and (dii) sending captured image data from the automated banking machine to at least one remote system address (Clark: column 3, lines 15-20), as in claim 29.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McNaughton discloses self service terminals with fraud detection. Petite discloses a system and method for monitoring the light level around an ATM. Anderson discloses a debit card fraud detection and control system. Smith discloses an ATM. Doig discloses a fraud prevention arrangement. Meskens discloses a near field detection device.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andy S. Rao whose telephone number is (571)-272-7337. The examiner can normally be reached on Monday-Friday 8 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571)-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andy S. Rao  
Primary Examiner  
Art Unit 2621

asr

/Andy S. Rao/

Primary Examiner, Art Unit 2621

October 25, 2008